Application No.: 10/064,812 Docket No.: JCLA8774

REMARKS

Present Status of the Application

The Office Action rejected Claims 1-20 under 35 USC 103(a) as being unpatentable over Harrington et al. (US-6,775,192) in view of Miner (US-6,862,704). Furthermore, Claims 1, 9, and 15 are objected to because of some minor informalities.

After entry of the foregoing amendments and traversing of rejections, Claims 1-20 remain pending in the present application, and reconsideration of those claims is respectfully requested.

Discussion of the claim rejection under 35 USC 103(a)

The Office Action rejected Claims 1-20 under 35 USC 103(a) as being unpatentable over Harrington et al. (US-6,775,192, hereinafter "Harrington") in view of Miner (US-6,862,704, hereinafter "Miner").

The following arguments are for the traversing of the rejections of Claims 1 – 20 under 35 USC 103(a) over Harrington in view of Miner.

The preambles containing "computer main board on/off testing device", "computer main board on/off testing method", or "computer main board on/off testing system" for Claims 1-20 of the present invention are all clearly **claim limitations** to each of their respective claim. This is because the aforementioned preambles are "necessary to give meaning" and "to properly define the invention..." Gerber Garment Technology Inc. v. Lectra Systems Inc., 16 USPQ2d 1436 (Fed. Cir. 1990). Without including the aforementioned "computer main board on/off testing device", "computer main board on/off testing method", or "computer main board on/off testing system" in the definition of each respective claim, the main test subject, which is the "computer main board", and the main test focus, which is the "on/off testing", would both be missing. Therefore, the "computer main board" and the "on/off testing" have to be included as part of the integral makeup of the proper definition for each of the respective claims in Claims 1-20.

Furthermore, "Any terminology in the preamble that limits the structure of the claimed invention must be treated as a claim limitation" is also stated in MPEP 2111.02. As a result, because the "computer main board on/off testing device" and the "computer main board on/off testing system"

are clearly **limiting the structure** of the claimed invention as shown in FIG. 1, in which the "computer main board on/off testing device 100" is shown. As a result, the "computer main board on/off testing device" and the "computer main board on/off testing system" are clearly claim limitations in each of their respective claims.

In addition, if the claim preamble is "necessary to give life, meaning, and vitality' to the claim, then the claim preamble should be construed as if in the balance of the claim." Pitney Bowes, Inc. v. Hewlett-Packard Co., 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165-66 (Fed. Cir. 1999). Therefore, the preamble containing the "computer main board on/off testing method" in Claims 15-20 is clearly necessary to give meaning and vitality to Claims 15-20 since it describes WHAT test is to be conducted (which is on/off testing) and defines the MAIN TEST SUBJECT (which is the computer main board).

Based upon the fact that the aforementioned preambles containing "computer main board on/off testing device", "computer main board on/off testing method", and "computer main board on/off testing system" are **claim limitations,** Claims 1 – 20 are then all patentably distinguish over Harrington in view of Miner because neither Harrington nor Miner teaches, suggests, or discloses a "computer main board on/off testing device", a "computer main board on/off testing method", or a "computer main board on/off testing system".

As shown in Table 1 below under the heading "Test Subject", the ***computer main board*** in the present invention used as a valid **claim limitation** is patentably distinguish over

Harrington and Miner. As a result, the aforementioned preambles containing the "computer main board on/off testing device" found in Claims 1-8, and 20, the "computer main board on/off testing method" found in Claims 15-20, and the "computer main board on/off testing system" found in Claims 9-14 are also patentably distinguish over Harrington and Miner.

As shown in Table 1 below under the heading "Test Scope", the ***on/off test procedure*** found in Claims 4, 18 and the ***for receiving and translating a write-in data from a specified port address and latching up the translated write-in data*** found in Claim 1 in the present invention are both patentably distinguish over Harrington and Miner.

As shown in Table 1 below under the heading "Test Interface", the ***through a standard interface for receiving and translating a write-in data*** found in Claim 1, the ***connected to a standard interface on the computer main board*** found in Claim 9, and the ***translating the write-in data through a standard interface*** found in Claim 15 are all patentably distinguish over Harrington and Miner.

Table 1. Nonobvious Differences Between Present Invention, Harrington, and Miner.

	Present Invention	Harrington	Miner
Test Subject	Computer Main Board "The **computer main board** 110 includes a standard interface such as a peripheral component interconnect (PCI) interface, a power on/off switch, a reset switch, a central processing unit (CPU), an advanced configuration & power interface (ACPI) and a basic input/output system (BIOS) such as an Award BIOS (or a Phoenix BIOS)." – Paragraph [0022]	Memory, DRDRAM – col. 4, lines 43-46	Memory in microprocessor – col. 4, lines 41-42 Microprocessor chip 610 – FIG. 6
Test Scope	Switching / Resetting Retrieving data from port address. Translating data through standard interface. Main Board on/off – Claims 15 Power Switching / Reset – Claims 17	Memory entering reduced power state. Generating calibration sequence. – col. 10, lines 45-51 Use of DRDRAM commands – FIG. 3	Apply parametric data to perform sequences of micro instructions. – col. 17, line 13- col. 18, line 8
Test Interface	PCI – Standard Interface – FIG. 1	Receptacle 212 – FIG. 2	Test Socket 628 – FIG. 6, and col. 12, lines 18-20

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CONCLUSION

For at least the foregoing reasons, it is believed that all the pending Claims 1-20 of the present application patently define over the prior art and are in proper condition for allowance. If the Examiner believes that a telephone conference would expedite the examination of the above-identified patent application, the Examiner is invited to call the undersigned.

Respectfully submitted,
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